03 - 27 - 06

DAC/ifw

# TRANSMITTAL FORM

*(to be used for all correspondence after initial filing)*
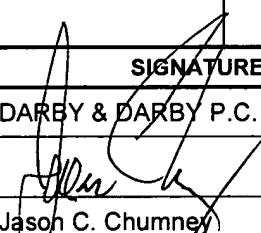
| | |
|---|---|
| Application Number | 10/750,138-Conf. #9762 |
| Filing Date | December 31, 2003 |
| First Named Inventor | David Gschneidner |
| Art Unit | 1621 |
| Examiner Name | D. D. Carr |

| Total Number of Pages in This Submission | | Attorney Docket Number | 01946/100G527-US2 |
|---|---|---|---|

## ENCLOSURES *(Check all that apply)*

| | | |
|---|---|---|
| [X] Fee Transmittal Form | [ ] Drawing(s) | [ ] After Allowance Communication to TC |
|    [X] Fee Attached | [ ] Licensing-related Papers | [ ] Appeal Communication to Board of Appeals and Interferences |
| [ ] Amendment/Reply | [X] Petition | [ ] Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) |
|    [ ] After Final | [ ] Petition to Convert to a Provisional Application | [ ] Proprietary Information |
|    [ ] Affidavits/declaration(s) | [ ] Power of Attorney, Revocation Change of Correspondence Address | [ ] Status Letter |
| [ ] Extension of Time Request | [ ] Terminal Disclaimer | [X] Other Enclosure(s) (please identify below): |
| [ ] Express Abandonment Request | [ ] Request for Refund | Return Receipt Postcard |
| [ ] Information Disclosure Statement | [ ] CD, Number of CD(s) _____ | |
| [ ] Certified Copy of Priority Document(s) |    [ ] Landscape Table on CD | |
| [ ] Reply to Missing Parts/ Incomplete Application | **Remarks** | |
|    [ ] Reply to Missing Parts under 37 CFR 1.52 or 1.53 | | |

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | |
|---|---|
| Firm Name | DARBY & DARBY P.C. |
| Signature | |
| Printed name | Jason C. Chumney |
| Date | March 24, 2006 |

| Reg. No. | 54,781 |
|---|---|

**Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**

# FEE TRANSMITTAL
## For FY 2006

| Complete if Known | |
|---|---|
| Application Number | 10/750,138-Conf. #9762 |
| Filing Date | December 31, 2003 |
| First Named Inventor | David Gschneidner |
| Examiner Name | D. D. Carr |
| Art Unit | 1621 |

[ ] Applicant claims small entity status. See 37 CFR 1.27

| TOTAL AMOUNT OF PAYMENT | ($) 130.00 | Attorney Docket No. | 01946/100G527-US2 |
|---|---|---|---|

## METHOD OF PAYMENT (check all that apply)

[x] Check  [ ] Credit Card  [ ] Money Order  [ ] None  [ ] Other (please identify): _____

[ ] Deposit Account  Deposit Account Number: 04-0100  Deposit Account Name: Darby & Darby P.C.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

[ ] Charge fee(s) indicated below

[ ] Charge fee(s) indicated below, **except for the filing fee**

[x] Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17

[x] Credit any overpayments

## FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)

### 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

| Application Type | FILING FEES Fee ($) | FILING FEES Small Entity Fee ($) | SEARCH FEES Fee ($) | SEARCH FEES Small Entity Fee ($) | EXAMINATION FEES Fee ($) | EXAMINATION FEES Small Entity Fee ($) | Fees Paid ($) |
|---|---|---|---|---|---|---|---|
| Utility | 300 | 150 | 500 | 250 | 200 | 100 | _____ |
| Design | 200 | 100 | 100 | 50 | 130 | 65 | _____ |
| Plant | 200 | 100 | 300 | 150 | 160 | 80 | _____ |
| Reissue | 300 | 150 | 500 | 250 | 600 | 300 | _____ |
| Provisional | 200 | 100 | 0 | 0 | 0 | 0 | _____ |

### 2. EXCESS CLAIM FEES

| Fee Description | Fee ($) | Small Entity Fee ($) |
|---|---|---|
| Each claim over 20 (including Reissues) | 50 | 25 |
| Each independent claim over 3 (including Reissues) | 200 | 100 |
| Multiple dependent claims | 360 | 180 |

| Total Claims | Extra Claims | Fee ($) | Fee Paid ($) |
|---|---|---|---|
| 29 - 31 = | _____ x _____ = | | _____ |

HP = highest numer of total claims paid for, if greater than 20.

| Indep. Claims | Extra Claims | Fee ($) | Fee Paid ($) |
|---|---|---|---|
| 1 - 6 = | _____ x _____ = | | _____ |

HP = highest numer of independent claims paid for, if greater than 3.

**Multiple Dependent Claims**

| Fee ($) | Fee Paid ($) |
|---|---|
| _____ | _____ |

### 3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

| Total Sheets | Extra Sheets | Number of each additional 50 or fraction thereof | Fee ($) | Fee Paid ($) |
|---|---|---|---|---|
| _____ - 100 = | _____ /50 | _____ (round up to a whole number) x | _____ = | _____ |
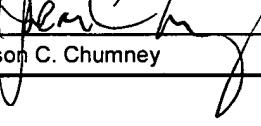
### 4. OTHER FEE(S)

| | Fees Paid ($) |
|---|---|
| Non-English Specification, $130 fee (no small entity discount) | |
| Other (e.g., late filing surcharge): 1464 Petitions to the Director to review restriction requirement | 130.00 |

## SUBMITTED BY

| Signature | | Registration No. (Attorney/Agent) | 54,781 | Telephone | (212) 527-7700 |
|---|---|---|---|---|---|
| Name (Print/Type) | Jason C. Chumney | | | Date | March 24, 2006 |

Application No. (if known): 10/750,138          Attorney Docket No.: 01946/100G527-US2

# Certificate of Express Mailing Under 37 CFR 1.10

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Airbill No. **EV 762808180 US** in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA  22313-1450

on          March 24, 2006
                       Date
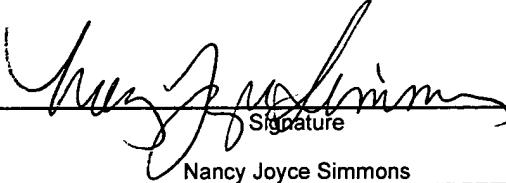
_____
                         Signature
_____
                Nancy Joyce Simmons
Typed or printed name of person signing Certificate

_____          212-527-7700
Registration Number, if applicable          Telephone Number

Note:    Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

Transmittal (1 page)
Fee Transmittal Form (1 page)
Petition Under 37 CFR 1.144 (3 pages)
Check no. 11563 in the amount of $130.00
Return Receipt Postcard

Docket No.: 01946/100G527-US2
(PATENT)

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
David Gscheidner et al.

Application No.: 10/750,138                    Confirmation No.: 9762

Filed: December 31, 2003                       Art Unit: 1621

For:  COMPOUNDS AND COMPOSITIONS FOR          Examiner: D. D. Carr
      DELIVERING ACTIVE AGENTS

## PETITION UNDER 37 CFR §1.144

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants respectfully petition the Director to review the restriction requirement issued in the June 29, 2005 Office Action, and rejoin claims 2-12 and 15-31. The required fee of $130 for this petition is submitted herewith. The Commissioner is authorized to charge any additional fees due with this submission to Deposit Account No. 04-0100.

### Pertinent Facts of the Case

1) On June 29, 2005 the Examiner issued a Restriction Requirement, designating two groups. The first group contained claim 1, which was drawn to eleven compounds. The second group contained claims 2-29, and was drawn to a composition, dosage unit form, and method of using the composition. All of the claims of group II depend from claim 1.

2) On August 4, 2005 Applicants filed an Amendment removing ten of the eleven compounds from claim 1. Applicants also traversed the restriction requirement, arguing that the entire set of claims could be examined without serious burden on the Examiner under MPEP § 803.

3) In a September 13, 2005 Office Action, the Examiner refused to withdraw the restriction requirement and made it final. Claims 2-31 were deemed withdrawn as drawn to a non-elected invention.

4) In a November 17, 2005 Amendment, claims 13 and 14 were canceled. Applicants also requested that the remaining claims (claims 2-12 and 15-31) be rejoined pursuant to M.P.E.P. § 821.04(a), since these claims depend from claim 1.

5) In a February 24, 2006 Office Action, claim 1 was allowed and the Examiner requested cancellation of the non-elected claims. The Examiner stated that "[a] withdrawn claim that does not [sic: is not] commensurate in scope with the allowable claim will not be rejoined."

## Argument

Applicants respectfully submit that the Examiner has improperly refused rejoinder of claims 2-12 and 15-31 on the basis that these claims are not "commensurate in scope." MPEP § 821.04 (a) states:

> When all claims to the nonelected invention(s) depend from
> or otherwise require all the limitations of an allowable
> claim, applicant **must** be advised that claims drawn to the
> nonelected invention have been rejoined and the restriction
> requirement has been withdrawn.

MPEP § 821.04(a) does not mention whether the nonelected claims are "commensurate in scope". This section does, however, require that claims drawn to nonelected inventions be rejoined if they depend from or otherwise require all the limitations of an allowable claim (claim 1). This is the case here.

## Summary

In view of the above, Applicants respectfully request rejoinder of claims 2-12 and 15-31.

Dated: March 24, 2006

Respectfully submitted,

By _____
Jason C. Chumney
    Registration No.: 54,781
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Attorneys/Agents For Applicant